

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No : 10/596,489 Confirmation No. : 7292
Applicant : Abdur-Rashid, Kamaluddin
Filed : March 20, 2007
Title : Asymmetric Imine Hydrogenation Processes
TC./A.U. : 1621
Examiner : Nwaonicha, Chukwuma O
Docket No. : 14696-13

Honorable Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

DECLARATION UNDER 37 CFR §1.132

I, Kamaluddin Abdur-Rashid, a citizen of Canada, and resident of Mississauga, Ontario, Canada, declare that the following facts are within my knowledge and are true.

1. I reside at 3414 Joan Drive, Mississauga, Ontario, Canada L5B 1T5.
2. I am the inventor and owner of the subject matter as claimed in U.S. Patent Application No. 10/596,489 filed March 20, 2007 (hereafter "the Application").
3. I have read and understood the Office Action that issued for the Application on January 6, 2009. The Examiner is of the view that claims 1, 3, 5-15, 16-19 and 25-53 are obvious in light of Cobley et al. (US 6,528,687) in view of Abdur-Rashid (WO 03/097571).
4. I am also a co-inventor, along with Robert H. Morris, of PCT Applicant No. WO 03/097571, entitled Process for Hydrogenating Unactivated Imines Using



Ruthenium Complexes as Catalysts, which the Examiner has cited in this Office Action.

5. I herein enclose a copy of an assignment dated May 8, 2003, which assigned Robert H. Morris's entire right, title and interest in United States Provisional Patent Application No. 60/380,256 throughout the world, to myself.

6. I submit that United States Provisional Patent Application No. 60/380,256 is the priority application for Abdur-Rashid (WO 03/097571). I therefore submit that the present application (10/596,489) and Abdur-Rashid (WO 03/097571) are commonly owned.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statement and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the Application or patent resulting therefrom.

March 31, 2009
Date

Kamaluddin Abdur-Rashid
Kamaluddin Abdur-Rashid

Appendix C

Assignment

I,

Dr. Robert H. Morris

Address: 114 Browning Ave, Toronto, Ontario, M4K
1W3

(hereinafter called ASSIGNOR)

in consideration of ONE DOLLAR (\$1.00) and other good and valuable consideration, the receipt of which is hereby acknowledged, do hereby sell, assign and transfer to:

Dr. Kamaluddin Abdur-Rashid

Address: 3816 Morning Star Drive, Mississauga, Ontario, L4T 1Y9

(hereinafter called ASSIGNEE)

and its successors and assigns,

(i) ASSIGNOR'S entire right, title and interest throughout the world in and to:

- (a) "Catalytic Procedure for the Preparation of Chiral Dialkyl Amines by Catalytic Hydrogenation of Imines" as described in University of Toronto Confidential Invention Disclosure, Disclosure Reference No: RIS 880 dated March 5, 2002 signed by Prof. Robert H. Morris and Dr. Kamaluddin Abdur-Rashid as joint inventors, which has been assigned by Prof. Robert H. Morris and Dr. Kamaluddin Abdur-Rashid to The Governing Council of the University of Toronto on March 21, 2002 and assigned by The Governing Council of the University of Toronto to Prof. Robert H. Morris and Dr. Kamaluddin Abdur-Rashid as such Assignment has been amended April 1, 2002, including all subject matter disclosed in United States Provisional Patent Application Serial No. 60/380,256, filed May 15, 2002;
- (b) "Hydrogenation of Imines Using Ruthenium Tetradentate complexes as Catalysts", as described in University of Toronto Confidential Invention Disclosure, Disclosure Reference No: 10000987a dated February 7, 2003 signed by Dr. Kamaluddin Abdur-Rashid as inventor, which has been assigned by Dr. Kamaluddin Abdur-Rashid to The Governing Council of the University of Toronto on March 19, 2003 and assigned by The Governing Council of the University of Toronto to Dr. Kamaluddin Abdur-Rashid as owner on March 25, 2003 and in University of Toronto Confidential Invention Disclosure, Disclosure Reference No: 10000987b dated February 24, 2003 signed by Prof. Robert H. Morris as inventor, which has been assigned by Prof. Robert H. Morris to The Governing Council of the University of Toronto on March 26, 2003 and assigned by The Governing Council of the University of Toronto to Prof. Robert H. Morris as owner on March 31, 2003.

(collectively, the "Assigned Inventions"); and

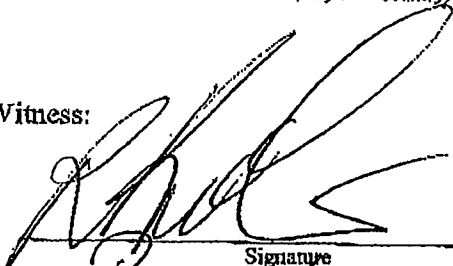
- (c) all rights granted by Firmenich SA ("Firmenich") to the ASSIGNOR and ASSIGNEE by virtue of the letter agreement, dated October 2, 2001, between Firmenich, the Governing Council of the University of Toronto, and the ASSIGNOR and ASSIGNEE

(collectively, with the Assigned Inventions, the "Assigned Assets");

- (ii) all of ASSIGNOR'S corresponding right, title and interest in and to any Letters Patent which may issue from the Assigned Inventions, including ASSIGNOR'S entire right, title and interest in and to any and all patents, reissues, extensions thereof and any divisional, continuation, continuation-in-part, or substitute application which may be filed on the Assigned Inventions in any country; and the issuing authorities are authorized and requested to issue any and all patents on the Assigned Inventions to ASSIGNEE, the same to be held and enjoyed by ASSIGNEE to the full end of the term for which the said patent is granted and maintained, as fully and entirely as the same could have been held and enjoyed by ASSIGNOR.

Executed at Toronto, Canada this 8 day of May 2003
(City and Country) (Day) (Month)

Witness:


 Signature

Drant Latham
 Name

May 8 / 03
 Date:

Dr Morris
Dr. Robert H. Morris

Name:

Title:

Date: